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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/155,590	09/30/98	SCHLOM	2026-4230US1

HM12/0203

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EXAMINER

ROBINSON, H

ART UNIT	PAPER NUMBER
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1653

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DATE MAILED: 02/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/155,590**

Applicant(s)  
**Schlom et al.**

Examiner  
**Hope Robinson**

Group Art Unit  
**1653**



☒ Responsive to communication(s) filed on Dec 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-65 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-65 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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*Election/Restriction*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, Claim(s) 1-31 and 45-62, drawn to a mutant ras peptide classified in class 530, subclass 350.

Group II, Claim(s) 32-41, drawn to a pharmaceutical composition, classified in class 514, subclass 12.

Group III, Claim(s) 42-44, drawn to an isolated DNA and vector, classified in class 536, subclass 23.1 and class 435, subclass 530.1.

Group IV, Claim(s) 63-65, drawn to cytotoxic T lymphocyte, classified in class 435, subclass 343.2.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The peptide of Invention I is related to the

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pharmaceutical composition of Invention II since the peptide is used in the composition, however, the two inventions are distinct because Invention I has a method of using the peptide independent of Invention II and the peptide isn't the only product used in the composition of Invention II.

In addition, the nucleic acids of Invention III are related to the protein of Invention I by virtue of encoding same. The DNA molecule has utility for the recombinant production of the protein in a host cell, not recited. Although the DNA molecule and protein are related since the DNA encodes the specifically claimed protein, they are distinct inventions because the protein product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for processes other than the production of the protein, such as nucleic acid hybridization assay.

Invention II is patentably distinct from Invention III because the product of Invention III is not used directly in the composition of Invention II. Additionally, the products of Invention III and IV are patentably distinct, having differing function, structure and chemical and physical entities.

Therefore, the search for the nucleic acid does not require search for either the pharmaceutical composition, T lymphocyte or the mutant ras peptide. They are not obvious variants and are different products. Furthermore, 37 CFR 1,475 (b) does not provide for more than 1 product as a combination of invention.

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3. A telephone call was made to Ms. Kathryn Brown on 1/21/00 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 5:00 P.M (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S. F. Low, can be reached at (703)308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

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Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope A. Robinson, MS *HA*

Patent Examiner

*Supervising Patent*  
*Christopher S. F. Low*  
CHRISTOPHER S. F. LOW  
PRIMARY EXAMINER  
GROUP 1800/1600